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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/750361
Filing Date: 14 April 2011
Appellant(s): Nelson MINAR

Tracy M. Hitt, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3 March 2011 appealing from the Office action mailed 10 June 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Sheth et al., US 6,311,194 B1, 30 October 2001.

Gerszberg, US 6,044,403, 28 March 2000.

Minar, US 2005/0165615 A1, 28 July 2005.

"Atom Standard", a (seven page) Wikipedia article made of record 27 November 2009 by the examiner.

"RSS Advertising", weblog written October 2002 (made of record by the examiner 10 June 2010).

Official notice was taken that targeting ads by geography was common practice at the time of the instant invention.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 10 June 2010 with the following two changes: (a) paragraph 8, a "provisional" rejection intended to put the appellant on notice, has been deleted because it has no force of law; (b) In para. 7, 15, 21 and 23, "rejected under" has been changed to "unpatentable under".

DETAILED **ACTION**

Claim Interpretation

1. Note on interpretation of claim terms - Unless a term is given an "explicit" and "clear" definition in the specification (MPEP § 2106.II.C), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skilled in the art (MPEP § 2111). This means that the words of a claim must be given their "plain meaning" unless the plain meaning is inconsistent with the specification (MPEP § 2111.01.I and 2111.01.III). An explicit and clear definition must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes … but does not include …". An example does not constitute a "clear definition" beyond the scope of the example. An applicant may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning (MPEP § 2111.01.IV and 2173.05(a)).

2. **RSS**, **Really Simple Syndication** (hereafter **RSS**) and **Atom** are disclosed to be "exemplary syndicated content formats" (para. [0009] of the published application (US 20050165615A1). The spec. does not explicitly and clearly define "syndicated content format". Indeed, para. [0007] of the published application defines syndicated content formats in terms of **RSS** and **Atom**, so the disclosed definitions are circular.

3. The examiner interprets each **RSS** and **Atom** to be a "name used in trade", a nonproprietary name by which an article or product is known and called among traders or workers in the art (MPEP 608.01(v)). See "Atom Standard", a (seven page) Wikipedia article made of record 27 November 2009.

4. The examiner interprets **RSS** and **Atom** to be programming rules or guidelines, comparable to a book of grammar rules or guidelines for writing effective English. While the results of using **RSS** and **Atom** can be functional (just as the results of using English language symbols and Arabic numerals can be functional), **RSS** and **Atom** are themselves non-functional descriptive material and accordingly not given patentable weight.

5. The examiner interprets an **RSS/Atom feed/feed item** and a **RSS/Atom format compliant web feed** to be XML-based computer programs for syndicating content. (Para. [0007], [0054] and [0072] of the published application). **RSS/Atom feed/feed items** and **RSS/Atom format compliant web feeds** are not *per se* patentably distinct from any other XML-based computer program for syndicating content.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 11-13, 17-19, 21-25, 35-37, 42, 57-64 and 72-76 are unpatentable under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At numerous places beginning at claim 1 line 10, "separate", RSS feed item , ad item, etc., is indefinite: "Separate" from what?.

9. "RSS", "Real Simple Syndication" and "Atom" are indefinite. The examiner has interpreted these to be "names used in trade" (para. 3 above). Names used in trade are permissible in patent applications if:

   (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

   (B) In this country, their meanings are well-known and satisfactorily defined in the literature.

   Condition (A) or (B) must be met at the time of filing of the complete application (MPEP 608.01(v)).

10. Neither of these conditions is satisfied in the instant case. See para. 2 above and Atom Standard.

11. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe arbitrary rules or guidelines for writing computer programs in the XML language and, accordingly, the identification/description is indefinite.

12. This rejection can be overcome by deleting "RSS", "Real Simple Syndication" and "Atom" from the claims.

Claim Rejections - 35 USC § 102 and 35 USC § 103

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are unpatentable under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter "Sheth").

16. Sheth teaches (independent claims 1, 72 and 77) a method and system of generating information including targeted ads (col. 16 lines 37-55), the method (as represented by claim 1) comprising:

receiving, by at least one processor (*apparatus*, col. 5 lines 5-7, and *server cluster **510***, col. 16 line 56 to col. 17 line 9), a first syndicated content item (*XML assets*, col. 10 lines 43-45) to be distributed by an XML-based computer program for syndicating content (*an XML string*, col. 16 lines 37-40 and col. 14 lines 23-25), which reads on "for a Really Simple Syndication ('RSS') feed" (para. 5 above) provided by a syndicated content provider device (*syndicators*, col. 5 lines 34-40, and *server cluster **510***, col. 16 line 56 to col. 17 line 9), the first syndicated content item (Fig. 6) being an RSS feed item and including a first title, a first URL to a web page corresponding to the first syndicated content item, and a first description, the RSS feed being an RSS format compliant web feed (para. 5 above);

receiving, by at least one processor (as above), a first targeted ad item for the RSS feed (*an XML string* with *a URL reference to a semantically targeted advertisement*, col. 16 lines 37-44), the first targeted ad item being a separate RSS feed item (*a separate advertisement query*, col. 16 lines 12-14) and including a first targeted ad that has been provided by an advertiser (*an external advertisement provider*), a first targeted ad title for the targeted ad item, a first targeted ad URL to a web page corresponding to the first targeted ad, and a first targeted ad description (Fig. 6);

storing, on a computer storage device, the first syndicated content item and the first targeted ad item (col. 10 lines 15-16);

receiving a request for the RSS feed (col. 16 lines 12-14);

inserting, by at least one processor, the first targeted ad item at a location in the RSS feed (col. 16 lines 52-55), the first targeted ad item being inserted in response to a request for the RSS feed; and

providing, by at least one processor and in response to the request for the RSS feed, the RSS feed, the first syndicated content item and the first targeted ad item (col. 16 lines 52-55).

17. The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A):

"the location being adjacent to the first syndicated content item in the RSS feed".

Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

Sheth also teaches at the citations given above claims 2, 17-19, 23-25 (inherently, since the spec. does not explicitly and clearly define "first", "second" and "different"), 42, 62-64 (where "ad mixer" is whatever mechanism is used to combine the delivered content and ad, col. 16 lines 52-55 and no patentable weight is given to the ad item location in the RSS feed), 73 and 78.

18. For independent claim 72 and dependent claims 11-13, 23-25, 63 and 64, Sheth also teaches dynamically generating targeted ads with content, which reads on "inserting the targeted ad item in the RSS feed", "the targeted ad item being a separate RSS feed item". (See Sheth: col. 1 line 67 to col. 2 line 3; col. 14 lines 41-48 and 56-59, where *additional results available in other context or domains* reads on an ad supplied dynamically with the requested results; col. 15 lines 26-30, where the *Sony Classics* logo in the uppe4r right corner of each Fig. 13A-13C reads on ad; and col. 15 lines 51-56). Furthermore Sheth also teaches that ad items are mapped in the *WorldModel database of metadata* (col. 15 line 67 to col. 16 line 4 and col. 4 line 54 to cool. 5 line 14), just as the content is. The ads are inserted dynamically in the feed with the content, not "embedded" in the content feed.

19. Sheth also teaches claims 11-13 (col. 13 lines 54-64 and col. 14 lines 23-25) and claims 35-37 (col. 9 lines 46-50).

20. The following claims add only non-functional descriptive material (printed matter) and were not given patentable weight (para. 15 above): 18, 57-61 and 74-76 (the arrangement of text is a non-functional artistic or formatting detail).

21. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Sheth et al. (US006311194B1, hereafter "Sheth") in view of *RSS Advertising* (archived weblog made of record herewith). Sheth does not teach the targeted ad item location in the RSS feed being adjacent to the syndicated content item. *RSS Advertising* teaches (p. 1 of 8) the targeted ad item location in the RSS feed being adjacent to the syndicated content item. Because the ad item pertains to the content item, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of *RSS Advertising* to those of Sheth.

22. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because it is simple common sense to put related things together.

23. Claims 21 and 22 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Sheth, or alternatively, Sheth in view of *RSS Advertising*, and further in view of official notice. Sheth does not teach targeting ads by geography. This was a common means of targeting ads at the time of the instant invention. For example, ads for any certain merchant are only distributed in the regions where the merchant does business. Official notice of this common knowledge or fact well known in the art was taken in the Office action mailed 29 September 2008 (para. 13). Since applicant failed to traverse the examiner's assertion (para. 20 of the Office action mailed 12 March 2009), it is taken to be admitted prior art (MPEP 2144.03.C). Also see para. 26 below.

Response to Arguments

24. Applicant's arguments filed with an amendment on 26 February 2010 have been fully considered in the revised rejection.

Search for Allowable Matter

25. The examiner has searched this application for potentially allowable matter (i.e., a feature of the disclosed invention that would overcome a rejection of record) and regrets

to report that none was found. In particular, the examiner performed a search of the non-patent literature and a patent document search of targeting ads by geography (para. 23 above). The searches are being made of record herewith.

26. The NPL search identified *RSS Advertising* (para. 21 and 22 above), which illustrates the addition of an ad item near a content item in an RSS feed. The geographic targeting search identified Gerszberg et al. (US006044403A), which teaches offering personalized news delivery with ads targeted by geographic location. Since Sheth also teaches offering news feeds and targeted advertising, the addition of the teachings of Gerszberg to those of Sheth would be obvious.

27. If applicant believes any one or more features of the instant application are potentially patentable, it would behoove the applicant to clearly identify those features by an after-final filing under 37 CFR 1.116.

(10) Response to Argument

The appellant's argument is divided into four parts denoted by Roman numerals I to IV. These four parts do not correspond one-on-one to the four grounds of rejection. Parts "I" and "II" argue against the three prior-art rejections; part "III" argues against the rejection made under 35 USC 112; and part IV argues against the examiner's claim language interpretation. Claim interpretation underlies every rejection, so the appellant's argument will be addressed in the order of parts IV, III, I and II.

IV. The terms "RSS" and "Atom" are not properly construed as non-functional descriptive material [Brief pp. 11-12 of 24]

The appellant's argument is short and worth repeating here in its entirety:

> "At pages 2 and 3 of the final action, the Examiner 'interprets RSS and Atom to be programming rules or guidelines, comparable to a book of grammar rules or guidelines for writing effective English ... that are themselves non-functional descriptive material and accordingly not given patentable weight.' **Appellant disagrees because the recitation of RSS (and Atom) in the claim language specifies a specific type of data that is required to be received, inserted, and provided to perform the claimed method**. For example, an application on a user device that retrieves RSS feeds can process data that is provided in the RSS format

and present content corresponding to the data to the user. However, if the data that is provided is not in a proper format (e.g., the RSS format), the content of the RSS feed will not be presented to the user. Atom data has similar properties. Thus, the terms RSS and Atom are functional elements, such that RSS and Atom are not properly interpreted to be nonfunctional descriptive material." (Brief pp. 11-12 of 24, **emphasis** added)

In substance, the appellant argues that claiming the use of "RSS" or "Atom" specifies a specific type of data. But, in order for the data to be "specific" to "RSS" and "Atom", "RSS" and "Atom" need to be defined. "RSS" and "Atom" are not defined in the specification:

"2. **RSS**, **Really Simple Syndication** (hereafter **RSS**) and **Atom** are disclosed to be "exemplary syndicated content formats" (para. [0009] of the published application (US 20050165615A1). The spec. does not explicitly and clearly define "syndicated content format". Indeed, para. [0007] of the published application defines syndicated content formats in terms of **RSS** and **Atom**, so the disclosed definitions are circular." (Para. 2 of the final rejection mailed 10 June 2010. Emphasis in the original)

Therefore, the examiner is obligated to give "RSS" and "Atom" their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skilled in the art (MPEP § 2111):

"3. The examiner interprets each **RSS** and **Atom** to be a "name used in trade", a nonproprietary name by which an article or product is known and called among traders or workers in the art (MPEP 608.01(v)). See "Atom Standard", a (seven page) Wikipedia article made of record 27 November 2009.[1]

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[1] Here are the first five paragraphs of "Atom Standard": "The name **Atom** applies to a pair of related standards. The *Atom Syndication Format* is an XML language used for web feeds, while the *Atom Publishing Protocol (AtomPub* or *APP)* is a simple HTTP- based protocol for creating and updating web resources.

Web feeds allow software programs to check for updates published on a website. To provide a web feed, a site owner may use specialized software (such as a content management system) that publishes a list (or "feed") of recent articles or content in a standardized, machine-readable format. The feed can then be downloaded by websites that syndicate content from the feed, or by feed reader programs that allow Internet users to subscribe to feeds and view their content.

4. The examiner interprets **RSS** and **Atom** to be programming rules or guidelines, comparable to a book of grammar rules or guidelines for writing effective English. While the results of using **RSS** and **Atom** can be functional (just as the results of using English language symbols and Arabic numerals can be functional), **RSS** and **Atom** are themselves non-functional descriptive material and accordingly not given patentable weight.

5. The examiner interprets an **RSS/Atom feed/feed item** and a **RSS/Atom format compliant web feed** to be XML-based computer programs for syndicating content. (Para. [0007], [0054] and [0072] of the published application). **RSS/Atom feed/feed items** and **RSS/Atom format compliant web feeds** are not *per se* patentably distinct from any other XML-based computer program for syndicating content." (Para. 3-5 of the final rejection mailed 10 June 2010. Emphasis in the original)

In summary, the examiner interpreted each "RSS" or "Atom" to be a "name used in trade", which is non-functional descriptive material and need not be given patentable weight. The examiner also interpreted an "RSS" or "Atom" feed as something written in XML. but that hardly qualifies as a "specific type of data", because no means are disclosed to distinguish an "RSS" or "Atom" product from any other XML-based computer program for syndicating content. Just as there are books teaching how to write in English, "RSS" and "Atom" are books teaching how to write in XML. Indeed, just as there are books teaching how to write *business letters* in English, "RSS" and "Atom" teach how to write *syndication programs* in XML. In every case, the product is written respectively in English or XML, and, without further specification, is indistinguishable from any other product in English or XML.

A feed contains entries, which may be headlines, full-text articles, excerpts, summaries, and/or links to content on a website, along with various metadata.

The Atom format was developed as an alternative to RSS. Ben Trott, an advocate of the new format that became Atom, believed that RSS had limitations and flaws--such as lack of on-going innovation and its necessity to remain backward compatible-- and that there were advantages to a fresh design. [footnote omitted]

Proponents of the new format formed the IETF Atom Publishing Format and Protocol Workgroup. The Atom syndication format was published as an IETF proposed standard in RFC 4287 *(http://tools.ietf.org/html/rfc4287),* and the Atom Publishing Protocol was published as RFC 5023 *http://bitworking.org/projects/atom/rfcSO23.html).*"

The appellant has not disclosed how to distinguish an "RSS" or "Atom" feed product from any other any other XML-based feed product. That is because no such distinction exists. "RSS" and "Atom" are colloquial "names used in trade" that do not represent any specific thing. By themselves, "RSS" and "Atom" are merely words, non-functional descriptive material, and need not be given patentable weight.

There are specific versions of "RSS" and "Atom" discussed below, and those specific versions might be distinguished by their published details from all other XML products. However, the appellant has not disclosed, much less claimed, these specific, written standard versions of RSS and Atom.

III. The terms "RSS" and "Real Simple Syndication" are not indefinite under 35 U.S.C. § 112, second paragraph [Brief p. 11 of 24]

Appellant's argument is again worth quoting in its entirety:

> At pages 3 and 4 of the final action, the Examiner asserts that "'RSS' [and] 'Real Simple Syndication' are indefinite.[2] The examiner has interpreted these to be names used in trade," which are permissible if "in this country, their meanings are well-known and satisfactorily defined in the literature." The Examiner asserts that this condition is not satisfied.
>
> Despite asserting that the meanings of RSS and Real Simple Syndication are not well-known, the Examiner has cited the RSS Advertising reference, which not only consistently references RSS feeds, but also provides several code examples of RSS feed items provided by users. Thus, the RSS Advertising reference demonstrates that the meaning of RSS was well- known at the time that the present application was filed. Additionally, **according to http://web.resource.org/rss/1.0/, the RSS 1.0 specification was released December 6, 2000**. Thus, not only was the meaning of RSS well-known at the time that the present application was filed, but RSS was also satisfactorily defined by the RSS 1.0 specification, which was released prior to the filing of the present application. For at least this reason, the terms "RSS" and "Really

[2] Here the appellant is arguing against the "provisional" rejection at para. 8 of the Office action. The appellant never argues against the rejection under 35 USC 112 at para. 7 of the Office action.

> Simple Syndication" are not indefinite. (First two para. on Brief p. 11 of 24, emphasis added)

As a preliminary matter, **the appellant appears to have impermissibly introduced new evidence, the website reference to "RSS 1.0" in bold**. The examiner cannot find that this website was made of record during prosecution.

The appellant argues that "RSS" is definite because (1) it is well known and (2) defined by the specification for RSS 1.0. Considering the first argument, as the appellant notes, the criterion is whether or not the meaning of the term is well known and satisfactorily defined in the literature. The examiner has searched widely and could not find an "explicit" and "clear" definition of "RSS" in the specification or elsewhere.

Neither has the appellant. In lieu, the appellant argues that "RSS" is defined by "RSS 1.0". First, "RSS 1.0" is not disclosed in the instant spec. If appellant wanted "RSS" to be limited to "RSS 1.0", the appellant needed to say so in the spec. when it was filed.

Second, appellant has submitted no evidence that "RSS" is widely known and used as shorthand for "RSS 1.0". The examiner submits that it is not. Consider the table of contents on the first page of "Atom Standard":

"Contents

- 1 Usage
- 2 Atom compared to RSS 2.0
  - 2.1 Content model
  - 2.2 Date formats
  - 2.3 Internationalization
  - 2.4 Modularity
- 3 Barriers to adoption
- 4 Development history
  - 4.1 Background
  - 4.2 Initial work
  - 4.3 Atom 0.3 and adoption by Google
  - 4.4 Atom 1.0 and IETF standardization
- 5 Example of an Atom 1.0 feed
  - 5.1 Including in XHTML
- 6 See also
- 7 References
- 8 External links"

Listed are specific versions of "Atom" and "RSS", including "RSS 2.0", "Atom 0.3" and "Atom 1.0". There is no evidence that one of ordinary skill in the art would understand

"RSS" to be shorthand meaning only "RSS 1.0". "RSS" could clearly also refer to "RSS 2.0", or to any other past or future RSS specification. "RSS" and "Atom" are each a "name used in trade", and indefinite under criteria established by the law (para. 9-11 of the final rejection, reproduced above).

It is noted for the Board's benefit that the examiner apparently did not properly reject claims 77 and 78 under 35 USC 112, second paragraph. Claims 77 and 78 were inadvertently omitted from para. 7 of the final rejection (reproduced above). Should the Board choose to affirm the examiner's rejection of all the claims under 35 USC 112, second paragraph, it is suggested the Board consider using its authority to expressly extend the examiner's rejection to claims 77 and 78.

I. Sheth fails to teach, describe, or suggest inserting the first targeted ad item at a location in the RSS feed, as recited by claim 1, and as similarly recited by independent claims 72 and 77 [Brief pp. 5-8 of 24]

In this part the appellant is traversing the examiner's rejection of claims under 35 USC 102(b). The appellant considers only independent claim 1 in detail, extending the traverse to independent claims 72 and 77, as the examiner did in the subject final rejection.

The appellant argues

> "First, Sheth does not disclose an RSS feed (or another syndicated web feed, such as an ATOM feed) or that any RSS feed items are inserted into an RSS feed. Therefore, Sheth cannot be properly construed as disclosing the claimed insertion of RSS feed items into an RSS feed.
>
> Second, neither the XML string nor the URL reference that are referred to in this passage of Sheth is a targeted ad item that is inserted into an RSS feed." (Brief p. 6 of 24, last two paragraphs)

First, as noted above, no patentable weight was given to the claim term "RSS" because it is non-functional descriptive material. The rejection is valid without a specific teaching of "RSS". As also noted above, XML reads on "RSS". Second, the appellant has misquoted the claim limitation, which is,

inserting, by at least one processor, the first targeted ad item at a location in the RSS feed (claim 1, line 15).

Sheth teaches this limitation as,

> "The second form of targeted advertising would involve creating an XML string that represents queries that the user performs or individual media assets in which the user has an interest. This XML string could then be sent to an external advertisement provider along with a user's session and profile information. The advertisement provider would process this information and return a URL reference to a semantically targeted advertisement.
>
> An extractor program takes HTML pages and extraction rules as input and generates XML assets such as that shown in FIG. 6. These generated assets contain values for each attribute name belonging to the domain of that Web site. Once created, the assets are sent to a Metabase Agent that is in charge of enhancing and inserting them into a database of records." (Sheth, col. 16, lines 37-44 and col. 10 lines 43-49, emphasis added

In summary, Sheth teaches generating a URL reference to a semantically targeted advertisement, which reads on "the first targeted ad item"; generates XML assets such as that shown in FIG. 6 from the URL reference, where XML assets reads on the claimed "RSS feed" (one of skill in the art would understand that "HTML pages" are the Web pages at the URL reference); and inserting them into a database of records, which reads on "inserting, by at least one processor, the first targeted ad item at a location in the RSS feed". This teaching is based on the broadest reasonable interpretation of "RSS feed", where again XML reads on "RSS" and anything intended for delivery is a 'feed". The targeted advertisement is inherently intended for delivery to the target. Although the appellant did not raise the argument, it is noted that Sheth also teaches syndicated feed as a *content syndicator* (col. 5, lines 34-40).

II. Sheth, RSS Advertising, and asserted combinations thereof fail to disclose inserting, in response to the request for the RSS feed, the first targeted ad item at a location in the RSS feed that is adjacent to the first syndicated content item, as recited by claim 1 [Brief pp. 8-11 24]

Here the appellant argues against the two prior art rejections under 35 USC 103(a). These differ from the prior art rejection under 35 USC 102(b) only in that the examiner has now given patentable weight to "RSS" and added a second reference, "RSS Advertising", that teaches "RSS" and inserting an ad adjacent to "content" in the RSS feed. It is instructive to first look at the first rejection under 35 USC 103(a):

> "21. Claims 1, 2, 4, 11-13, 17-19, 23-25, 35-37, 42, 56-67, 69-73 and 75-78 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Sheth et al. (US006311194B1, hereafter "Sheth") in view of RSS Advertising (archived weblog made of record herewith).[3] **Sheth does not teach the targeted ad item location in the RSS feed being adjacent to the syndicated content item. RSS Advertising teaches (p. 1 of 8) the targeted ad item location in the RSS feed being adjacent to the syndicated content item**. Because the ad item pertains to the content item, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of RSS Advertising to those of Sheth.
>
> 22. In addition, under KSR v. Teleflex (82 USPQ 2nd 1385), the combination would be obvious because it is simple common sense to put related things together." (Para. 21-22 of the final rejection mailed 10 June 2010. **Emphasis** added)

Again, as indicated in bold, "RSS Advertising" was added only for the teaching of a targeted ad item being adjacent to a syndicated content item in RSS feed. The content is the news item, "American Awarded Nobel for Economics", and the adjacent ad is the Jaguar ad immediately preceding the news item. The appellant argues,

> "RSS Advertising does not disclose 'inserting ... the first targeted ad item at a location in the RSS feed ... in response to a request for the RSS feed.' For example, RSS Advertising recites '**embedding** text ads into RSS feeds,' which according to the present application is not the same as 'inserting an ad item into an RSS feed in **response to** a **request for the RSS feed.**'" (Brief p. 9 of 24, end of top paragraph; emphasis in original)

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[3] In the eDAN database, as of this writing "RSS Advertising" does not appear under the "Prior Art" tab: the document appears only as the 8-page "NPL" dated 06/10/2010 under the "Prosecution" tab.

This argument is a very weak straw man. The rejection does not say the second reference teaches "inserting"; the rejection relies on the first reference, Sheth, for this inserting feature. The appellant goes on to argue that "embedding" the ad is much less desirable than "inserting" it because embedding "complicates tracking and viewing of advertisements by end users". Of course. That is why Sheth teaches dynamic targeting:

> "The methods and apparatus of the present invention allow for semantic and immediate interest targeting. Those methods can instantaneously select and display commercial advertisements based on the semantic context that the Web user is currently browsing." (Sheth, col. 15, lines 51-56, emphasis added)

Embedding an ad would obviate dynamic targeting, making the primary reference (Sheth) unworkable. One of ordinary skill in the art would understand that the embedding feature of the secondary reference must be ignored in order to maintain the dynamic targeting feature of the primary reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Donald L. Champagne/
Primary Examiner, Art Unit 3688

Conferees:

John Weiss
/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3688

/David Okonsky/
Supervisory Patent Examiner, Art Unit 3600